

REMARKS

Applicant has studied the Office Action dated February 6, 2009. As a preliminary matter, it is respectfully noted that the Office Action Summary in the present Final Office Action lists the pending claims as 75-79, 91-93, 96, 97 and 99. However, it is respectfully submitted that claim 94 also is pending and is specifically addressed on page 3 of the present Final Office Action. It is further respectfully submitted that claims 63-67, 80-89 and 98 were withdrawn in response to a Restriction Requirement but never canceled and are, therefore, still pending.

Claim 75 has been amended and claims 93, 94 and 99 have been canceled without prejudice. It is submitted that the amendments to the claims have support in the application as originally filed and, therefore, no new matter has been added.

Claims 63-67, 69-71, 75-89, 91, 92 and 96-98 are pending, with claims 63-67, 69-71, 80-89 and 98 having been previously withdrawn from consideration. Claims 63 and 75 are independent claims.

It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 103 Rejections

Claims 75-79, 91-94, 96, 97 and 99 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsu (U.S. Pat. No. 5,907,604) in view of Lev et al. ("Lev" U.S. Pat. No. 5,987,327). These rejections are respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkenaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill

in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

With this paper, claims 93, 94 and 99 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot with respect to claims 93, 94 and 99 and it is respectfully requested that the rejection be withdrawn.

It is respectfully noted that independent claim 75 has been amended with this paper to incorporate the subject matter of claim 93, which has been canceled without prejudice. Therefore, independent claim 75, which now recites that the receiving party unilaterally changes the selected format for transmitting the media information, will be discussed with respect to the rejection of claim 93 as well as with respect to the rejection of claim 92.

It is again respectfully noted, as was done in previous responses, that the present invention is directed to allowing the "communicating parties" to "control the amount of information they want to transmit based on how much they are willing to pay for various communication services" and to allow "users to control the types of media services that they would like to receive, thereby allowing the users to control costs and the extent of media services to be received." See specification at paragraphs 19 and 68.

It is again further respectfully noted, as was done in previous responses, that the present invention is directed to one embodiment where the receiving party may "designate one or more service options he or she would like to receive" in order to "control the type of media information to be received" and that the "user of the receiving terminal may enter into an agreement with the wireless carrier to ensure that only lower-bandwidth media is displayed" via a "controller at the switching station which blocks or otherwise filters out higher-bandwidth media" or "the receiving terminal may be configured to block display of higher-bandwidth media, even though it may have been sent by the transmitting terminal" or "the receiving terminal may be programmed to replace received media information with alternative media information stored in a terminal memory." See specification at paragraphs 37-47. It is again respectfully submitted, as was done in previous responses, that claim 93, which has been canceled

and its limitations incorporated into independent claim 75, was directed to this embodiment.

Canceled Claim 93

It is respectfully noted that the Examiner, at paragraph 3 on page 3 of the present Final Office Action with respect to claim 93, asserts that Hsu discloses “the receiving party selects the at least one format for transmitting the media information.” It is further respectfully noted that the Examiner indicates, at paragraph 3 on pages 3-4 of the present Final Office Action with regard to independent claim 75, that Hsu fails to disclose “the calling party or the receiving party can unilaterally change the selected format for transmitting the media information.”

As was done in the previous response to Office Action, it is again respectfully submitted that the Examiner has failed to address that claim 93 recited that the receiving party **unilaterally** selects the at least one format for transmitting the media information such that there is **unilateral** action by the receiving party. As was done in previous responses, it is again respectfully submitted that the Examiner has not indicated any asserted any specific analogies between the asserted portions of Hsu and the calling party and receiving party recited in claim 93.

With regard to the rejection of claim 93, it is again respectfully noted, as was done in previous responses, that the disclosure in Hsu is that “[v]ideophone 280 also receives composite video information from, e.g., external video cameras at 282” and that “[v]ideophone 280 transfers information to desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288.” See Hsu at col. 4, ll. 57-61. It is again further respectfully noted, as was done previous responses, that the disclosure in Hsu is that “[s]till camera 290 transfers picture information to the desktop PC, notebook PC and PDA.” See Hsu at col. 4, ll. 61-63.

It is again respectfully submitted, as was done in previous responses, that the proper interpretation of Hsu is that the “videophone 280,” “external video cameras at 282” and “still camera 290” in FIG. 4 of Hsu are located at the “calling party” and the “information” is transferred to a “desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288” that are located at the “receiving party.” As was done in previous

responses, the Examiner's attention is again respectfully directed to the disclosure at col. 2, ll. 14-23 of Hsu that it is the "calling party" that defines the "image" that is "associated with their Caller ID" and it is the "calling party" that transmits the "image" to the "receiving party" as well as to col. 5, ll. 13-55 of Hsu, which discloses that "the operations of image capture 350 ... are performed at the transmitting end ... performed by components at the sending, or calling, party's end." Moreover, it is again respectfully submitted, as was done in previous responses, that there is no disclosure in Hsu of any selection by the receiving party of any format for transmitting the media information, as was recited in claim 93 and is now recited in independent claim 75.

It is again respectfully noted, as was done in previous responses, Examiner has not indicated any asserted analogies between the calling party and receiving party recited in claim 93 and the "videophone 280, "external video camera," "desktop PC 284," "notebook PC 286" and "personal digital assistant (PDA) 288" in Hsu. It is again further respectfully submitted, as was done in previous responses, that the Examiner has not indicated how the disclosure in Hsu that the "videophone 280 also receives compost video" is analogous to the "videophone 280" or "external video camera" selects any format nor how the "[v]ideophone 280 transfers information" is analogous to the "videophone 280" or "desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288" selects any format.

It is again respectfully submitted, as was done in previous responses, that the only viable interpretation of Hsu is that "videophone 280," "external video cameras at 282" and "still camera 290" in FIG. 4 of Hsu are located at the "calling party" and the "information" is transferred to a "desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288" that are located at the "receiving party." Therefore, it is again further respectfully submitted, as was done in previous responses, that the only transmitting of media information between a calling party and a receiving party that is arguably disclosed in Hsu is of a "videophone 280" of a calling party transmitting media information to a "desktop PC 284, notebook PC 286 and personal digital assistant (PDA) 288" of a receiving party.

It is again respectfully submitted, as was done in previous responses, that the only portion of Hsu that arguably discloses which of the parties selects the format for

transmitting information is at col. 2, ll. 14-23 and col. 5, ll. 13-55 and the disclosure at those portions of Hsu is explicitly that it is the “calling party” or the “transmitting end” that performs all the operations. It is again further respectfully asserted, as was done in previous responses, that there is no disclosure in Hsu that the “receiving party” has any effect on the selected format.

Dependent Claim 92

It is respectfully noted that the Examiner, at paragraph 3 on page 5 of the present Final Office Action, indicates with regard to claim 92 that Hsu fails to disclose “an identification of the selected at least one format for transmitting the media information is stored in association with calling party identification information, and determined at the receiving party terminal.” It is further respectfully noted that the Examiner further asserts that “it would have been obvious that any chosen format of the calling party for transmitting the media information to the receiving party (col. 2, ln. 16-18) must be agreed in advance by both parties.”

It is again respectfully submitted, as was done in previous responses, that unlike the conventional system, the present invention is specifically directed to unilateral control of the format for transmitting the media information and, therefore, allows for the information that the calling party transmits not being received by the receiving party. The Examiner’s attention is again respectfully directed, as was done in previous responses, to the present specification at paragraphs 73-74, which specifically discloses that “the transmitting terminal may transmit continuous video output from the camera unit in the terminal” but the “receiving terminal may capture and then display the video, and in the meantime may store the script” so that “the receiving terminal may display this script repeatedly … without requiring any additional allocation of network resources.”

Applicant again respectfully submits, as was done in previous responses, that the Examiner has not addressed the specific limitations recited in claim 92 and that the “obvious” result of the Examiner’s asserted modification of Hsu would not anticipate the present invention as recited in claim 92. It is respectfully noted that claim 92 recites that that the receiving party **unilaterally** selects the at least one format for transmitting the

media information. It is again respectfully noted, as was done in previous responses, that the Examiner fails to acknowledge that claim 92 recites **unilateral** action by the receiving party.

Disclosure in Hsu

It is respectfully submitted that the only conclusion that may be drawn from the previous remarks with regard to the rejection of claims 75, 93 and 92 is that Hsu cannot be asserted as disclosing any unilateral action that is taken by the receiving party recited in the claims of the present invention with regard to the recited at least one format for transmitting the media information. Therefore, it is further respectfully submitted that the Examiner must be relying completely on the disclosure in Lev with regard to any unilateral action that is taken by the receiving party recited in the claims of the present invention with regard to the recited at least one format for transmitting the media information.

Disclosure in Lev

It is respectfully noted that the Examiner, at paragraph 3 on pages 4-5 of the Final Office Action, asserts that Lev cures the deficiency of Hsu with regard to “the calling party or the receiving party can unilaterally change the selected format for transmitting the media information,” as recited in independent claim 75. It is further respectfully noted that the Examiner asserts that Lev discloses “the calling party unilaterally decides on the minimum bandwidth requirement” and specifically asserts “that in figure 3, steps 205, 206, 209, 216, if there is no agreement, the message with regarding the bandwidth is being sent out (unilaterally change)” and further refers to the recitation of “the calling party or the receiving party can unilaterally change the selected format for transmitting the media information” in independent claim 75 as “interpreted as that both the calling party and the receiving party can unilaterally change the selected format, therefore, the system is interpreted broadly as capable of a bi-laterally changing the format.”

It is respectfully noted that the asserted FIG. 3 of Lev does not illustrate the asserted reference designators “205, 206, 209, 216” but rather illustrates reference

designators "305," "306," "309" and "316" while FIG. 2 of Lev illustrates reference designators "205, 206, 209, 216." It is further respectfully noted that Lev discloses at C. 9, ll. 10-11 that "FIG. 3 is a flowchart of a method, in accordance with the present invention, for use by a terminating switching center" and discloses at C. 5, ll. 6-7 that "FIG. 2 is a flowchart of a method, in accordance with the present invention, for use by an originating switching center." It is respectfully submitted that the entity in Lev to which the asserted specific reference designators "205, 206, 209, 216" correspond is of utmost importance to the interpretation of the disclosure in Lev as it applies to the claims of the present invention.

Although reference designators "205, 206, 209, 216" in Lev arguably support the "unilateral change" asserted by the Examiner, it is respectfully noted that the "unilateral change" is disclosed with respect to the "originating switching center" in Lev that is arguably analogous to the calling party recited in independent claim 75. However, it is further respectfully noted that reference designators "305," "306," "309" and "316" illustrated in FIG. 3 of Lev, which is directed to "a terminating switching center" that is arguably analogous to the receiving party recited in independent claim 75, do not support the "unilateral change" asserted by the Examiner. Therefore, it is respectfully submitted that the disclosure in Lev cannot be asserted as curing the deficiency of Hsu with regard to the recitation in independent claim 75 that the receiving party unilaterally changes the selected format for transmitting the media information.

Claims of Present Invention Are In Condition for Allowance

It is respectfully asserted that independent claim 75 is allowable over the cited references. It is further respectfully asserted that claim 92 also is allowable over the cited references by virtue of the limitations recited therein as well as by virtue of its dependence from allowable claim 75. Moreover, it is respectfully submitted that claims 76-79, 91, 96 and 97 also are allowable over the cited references at least by virtue of their dependence from allowable claim 75.

CONCLUSION

In view of the above remarks, Applicant submits that claims 75-79, 89-92, 96 and 97 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as originally filed, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

LEE, HONG, DEGERMAN, KANG & WAIMEY

By: 
/Richard C. Salfelder/
Richard C. Salfelder, Esq.
Registration No. 51,127
Attorney for Applicant(s)

Date: April 14, 2009

Customer No. 035884